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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,941	05/21/2001	Ola Olofsson	TPP 31386	9543

7590 01/15/2003
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EXAMINER

TRAN A, PHI DIEU N

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/806,941

Applicant(s)

OLOFSSON ET AL.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election of claims 1-7 is hereby confirmed. Claims 8-10 are withdrawn from further consideration. It appears the new claims 15 and 19 also read on the non-elected specie, and thus hereby withdrawn.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 11-14, 20-21, drawn to vertically joined flooring material, classified in class 52, subclass 582.1.
 - II. Claims 16-18, drawn to a method of joining flooring material, classified in class 52, subclass 745.19.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process; for example, the grooves and lips of the profiles being joined with the floorboards simultaneously.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
5. Newly submitted claims 15-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 15, 19 are directed to a decorative strip (20) in figures 2a-2c of a specie non-elected, and the specie 2a-2c is confirmed

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by applicant in the response 10/24/02 to be non-elected; the method claims 16-18 are to the method of joining flooring material.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 5, 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 line 2 “ the groove” is indefinite. It is unclear which groove is referred to. Is it the groove at the bottom or at the side of the panel?

Claim 5 “ the centers of the lips”, “the centers of the grooves” are lacking antecedent basis. It is also unclear what the centers are.

Claim 11 line 3 “ a floor board” is indefinite. Should it be “ the floor board”?

The claims are examined as best understood.

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1. PRODUCT BY PROCESS CLAIM:

“ The subject matter present in claim 6 is regarded as a product by process claim in which a product is introduced by the method in which it is made. It is the general practice of this office to examine the final product described regardless of the method provided by the applicant.”

This applies to the rejection of claim 6 below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (3884008).

Miller shows a joining profile having two lips (34) disposed at opposite ends and perpendicular to a middle section (26), a central cheek section (26) having first and second resilient cheeks (28) extending therefrom, each of the first and second resilient cheeks comprising a tongue (16) extending perpendicular with respect to the respective cheek, the cheeks are separated by a space large enough to permit deflection of one of the first and second cheeks without contacting the other of the first and second resilient cheeks.

4. Claims 13-14 rejected under 35 U.S.C. 102(b) as being anticipated by Brechin (3145503).

Brechin shows a joining profile having two lips (53, 52) disposed at opposite ends and perpendicular to a middle section (79), a central cheek section (79) having first and second resilient cheeks (44) extending therefrom, each of the first and second resilient cheeks comprising a tongue (20) extending perpendicular with respect to the respective cheek, the

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cheeks are separated by a space large enough to permit deflection of one of the first and second cheeks without contacting the other of the first and second resilient cheeks.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5-7, 11-12, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sweden (SU 8202375-5) in view of Pressell (4461131).

Sweden (figure 1) shows a vertically joined floor board comprising floor boards (1) with a polygonal shape upper surface, the boards are provided with edges (2) which are provided with a groove (7), a lower side (9), a decorative top surface (surfaces are inherently decorative by nature), the floor boards are joined by means of separate joining profiles (5), the edges are provided with one groove (8) each, the grooves are arranged parallel to its respective edge and that the joining profiles are provided with lips (11) arranged in pairs, the lips each is intended to be received by the groove of the floor board so that the adjacent floor boards are guided and fixed horizontally by the lips, the lips are connected to each other by a middle section (at 4-4) of the joining profile, the joining profile is provided with a central cheek, the cheek having an independently resilient cheek (10), the cheek is provided with tongues (12) wherein each tongue is received by one groove (7) so that adjacent floor boards are guided in the vertical direction, the distance of the grooves on the lower side to the closest edge being less than one half the width of

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a floor board, the distance of between each groove and the closest edge is about the same, the distance between the centers of the lips of the joining profile being less than the distance between the centers of the grooves placed on each side of and closest to the edge of two adjacent floor boards, the grooves on the lower side being arranged at a distance from the closest edge less than one quarter of the width of a floor board, the top and lower surface of a floor board being flush with those of an adjacent board respectively.

Sweden does not show the cheek being a first and a second independently resilient cheek.

Pressell shows a joining profile having a central cheek made up of a first and a second independently resilient cheeks (68) to join floor boards together vertically.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden to show the cheek being a first and a second independently resilient cheek because the examiner takes Office Notice of the equivalence of two cheek on a joining profile and one cheek on the joining profile for their use in the static structure art and the selection of any of these known equivalents to join the floor boards would be within the level of ordinary skill in the art.

Per claim 7, Sweden as modified by Pressell shows all the claimed limitations except for the floor boards or the joining profiles being partially coated with glue or adhesive tape.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden's modified structure to show the floor boards or the joining profiles being partially coated with glue or adhesive tape because it would enhance the secure joining of the floor boards to the joining members.

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7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sweden (SU 8202375-5) in view of Pressell (4461131) as applied to claim 2 above, and further in view of Schwartz (5058333).

Sweden as modified by Pressell shows all the claimed limitations except for the part of the floor board located between each edge and its respective groove is thinner than the maximum thickness of the floor board by means of a recess located on the lower side.

Schwartz discloses the part of the floor board located between each edge (40) and joined by a joining profile is thinner than the maximum thickness of the floor board by means of a recess located on the lower side to enable concealing the profile to allow for a smooth lower surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Sweden's modified structure to show the part of the floor board located between each edge and its respective groove is thinner than the maximum thickness of the floor board by means of a recess located on the lower side because it would enable the concealing of the profile to allow for a smooth lower surface as taught by Schwartz.

Response to Arguments

8. Applicant's arguments filed 10/24/02 to claims 1-7 have been fully considered but they are not persuasive.

Applicant states that SE'375 does not show the central cheek 10 being resilient. Examiner respectfully disagrees. As pointed out by applicant, cheek 6 is resilient. Cheek 6 and cheek 10 are both made of the same material and having the same configuration of “

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approximately” T-shapes. As cheek 6 is resilient, it is thus inherent that cheek 10 is also resilient. The argument is thus moot.

With respect to applicant’s assertion that it is not proper to combine Pressell with SE’375 as Pressell lacks the central cheek or the two independently resilient cheeks, examiner respectfully disagrees. As described in the rejection above, Pressell shows resilient cheeks 68 which certainly would limit the vertical movement per the groove and tongue of the cheeks. Pressell thus teaches the limitation of using two cheeks instead of one cheek to limit the movement of joining boards together. The teaching thus would render obvious the claims. The argument is thus moot.

With respect to applicant’s assertion that the one cheek is not equivalent to the two cheeks, examiner respectfully disagrees. The one cheek shown in SE’375 is inserted into panels to hold the panels in the vertical direction. The cheek provides resiliency for the insertion of the panels as the two claimed cheeks. The one cheek functions the same to insert into grooves on the panels as the two claimed cheeks. The Official Notice of equivalent is thus proper. The argument is thus moot.

With respect to applicant’s argument about claim 4, examiner would like to point to the rejection above which clearly sets forth that the combination of Schwartz with SE’375 and Pressell satisfies the claimed limitations. The argument is thus moot.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different floor boards with joining profiles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A *PA*
January 11, 2003

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

